



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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FRANK & EDWARDS
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

HM12/1017

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

10/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Advisory Action

Application No.
08/986,186

Applicant(s)
Peterson et al.

Examiner
John S. Brusca

Group Art Unit
1631



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on 9/18/00 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on 9/18/00 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

- ☒ Applicant's response has overcome the following rejection(s):

The objection to the specification regarding a lack of a paper copy of the sequence listing, and the rejection of claims 27-34, 36-41, 43-46, and 48-50 under 35 U.S.C. § 102.

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attachment

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: 27-33, 36-40, 43, 44, 46, and 48

Claims objected to: _____

Claims rejected: 34, 35, 41, 42, 45, 47, 49, and 50

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

JOHN S. BRUSCA
PRIMARY EXAMINER
ART UNIT 1631

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1. The Applicants point to disclosure in the instant specification of some (but not all) of the metabolic products and gene products mentioned in the claims, but the specification does not clearly discuss the claimed libraries comprising genes that result in synthesis of the metabolic products and gene products mentioned in the claims. Many of the claimed libraries discussed above were not addressed in the Applicant's comments.

Statements in the specification that merely mention the existence of metabolic products or gene products of donor organisms is not an adequate written description of a gene expression library that comprises genes that encode gene products mentioned in the claims or gene products that synthesize the metabolic products mentioned in the claims.

The Applicants state that the specification describes libraries that comprise genes involved in polyketide synthesis and peptide synthesis, however such libraries have not been rejected for lack of written description.

The Applicants have included in their response received 9/18/00 abstracts of prior art references that disclose genes that would be present in some but not all of the claimed libraries. The specification does not describe libraries that comprise genes involved in synthesis of mevalonic acid, glucose transfer systems, beta lactams, macrolides, alkaloids, bryostatins, carotenoids, steroids, retinoids, tetracycline, oxytetracycline, puromycin, doxyrubicin, taxol, chloramphenicol, nalidixic acid, mithramycin, novobiocin, vulpinic acid, usnic acid, kainic acid, podophyllotoxin, brevitoxin, camptothecin, or artemisinin. Such libraries have been specifically claimed. The specification does not refer to references that disclose genes that would necessarily

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be present in the claimed libraries. The Applicant's response received 9/18/00 may be an argument for enablement of libraries comprising genes disclosed in the attached abstracts, but the specification does not describe the claimed libraries or genes that would be necessarily present in the claimed libraries. The Applicants amended the pending claims to recite the above listed libraries in their amendment received 6/2/99. The amendment constitutes new matter and the rejection of claims 34, 35, 41, 42, 45, 47, 49, and 50 under 35 U.S.C., § 112, first paragraph for lack of written description is maintained.

2. Certain papers related to this application may be submitted to Art Unit 1631 by facsimile transmission. The FAX number is (703) 305-7939. In such cases please call the Examiner at (703) 308-4231 at the time of transmission to expedite delivery of the fax. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

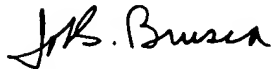
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read "J.S. Brusca".

John S. Brusca, Ph.D.

Primary Examiner